REMARKS

Claims 1-40 are pending. It is asserted that, for the reasons described below, the claims are in condition for allowance and favorable action in this regard is respectfully requested.

No claims have been withdrawn, cancelled, or amended, and no new claims have been added.

Priority Claim

Assignee notes the Examiner's statement in the Office Action regarding priority under 35 USC § 119(e) to prior application 60/397,542, filed July 22. 2002. The Examiner indicates that "at least claims 4-10, 12, 13, and 15-17 are not entitled to the priority date of the provisional application." Assignee again takes no position on this issue since it is not related to the issues currently in prosecution. However, Assignee specifically does not acquiesce in the Examiner's view on this issue. If this issue is later determined to legally affect patentability of the pending claims, it will be addressed by Assignee at that time. Currently, Assignee believes that the pending claims distinguish over documents applied byt the Examiner at least based on the effective filing date of the present non-provisional application under section 120 of the patent statute.

Claim Rejections Under 35 USC §102

Claims 1-9, 11-16, and 18-40 were rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 6,339,767 to Rivette et al. (hereinafter Rivette). This rejection of these claims on this ground is respectfully traversed.

The Manual of Patent Examining Procedure ("MPEP"), in § 2131, states:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Thus, under 35 USC § 102, a claim is anticipated *only if* each and every element of the claim is found in a single document applied by the Examiner. It is respectfully submitted that this standard has not been met in this instance.

Claim 1 recites "the second set being identified by at least two generations of search queries at least partially identified using the special purpose computer, in which any successive search query in comparison with the immediately preceding search query is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements without any human intervention."

The language of claim 1 recites elements or limitations not shown in or taught by Rivette et al. It is asserted that Rivette does not show or illustrate features of this language.

Assignee does not agree with the Examiner's characterization of Rivette. The Examiner, on pages 26-27 of the above referenced office action, interprets Rivette to show automatic formulation of recursive queries to retrieve multiple generations of cited/citing patent documents. Rivette discusses repetitive searching of data. This is demonstrated based on the portions of Rivette that the Examiner highlights. For example, Rivette, at col. 89, lines 15-16, states:

"The patent citation report module 1004 collects data for a multi-level patent citation report by repetitively performing the steps of flowchart 8602....."

However, flowchart 8602 refers to receiving data from a user. Therefore, this is not what the claim language is intended to cover, but, instead, relies upon a human operator on each iteration providing information to a computer. For example, the claim language

specifically recites: "without any human intervention." Therefore, Rivette does not meet this aspect of claim 1, however, Assignee distinguishes Rivette for additional reasons.

The Examiner is not correctly applying the language of pending claim 1 to Rivette in other respects. In particular, the Examiner is interpreting "generation" to refer to "generations of cited/citing patent documents;" however, generation is intended and used in the context of "generating" queries, instead. Therefore, the claim refers to: "at least two generations of search queries." **Rivette does not speak to generating a different query based at least in part on the results of a prior query, for example.**

Likewise, the Examiner is interpreting "data elements" to necessarily refer to "documents." This interpretation is also not the meaning intended. Rather, the specification refers to keywords, for example, in paragraphs 43-45 of publication 2004/0133562 (the published application). The Examiner appears to be applying the claim to families of patents where there are citations of documents occurring, however, the specification states, in paragraph 53 of the published application, that candidates may specifically include "those candidates for prior art that do not cite the starting patent publication and that are not cited by the starting patent publication."

It is therefore respectfully asserted that the Examiner has not correct applied the language of claim 1 to Rivette. Rather, it is asserted that there are several aspects of claim 1 not shown or illustrated by claim 1, as discussed above. Accordingly, it is respectfully requested that the rejection claim 1 under 35 USC §102(b) be withdrawn. Claims 11 and 24 contain similar limitations as claim 1, and thereby patentably distinguish on at least a similar basis. Likewise, claims 2-9 depend directly from claim 1; claims 12-16, 18-23 depend from claim 11; and claims 25-40 depend from claim 24. As such, claims 1-9, 11-16, and 18-40 also patentably

distinguish from Rivette on at least the same or similar basis. It is, therefore, respectfully requested that the Examiner withdraw the rejection of these claims.

35 USC §103 Rejection

Claims 10 and 17 were rejected under 35 USC §103 on Rivette in view of Coleman. This rejection of these claims on this ground is respectfully traversed.

The combined documents, whether considered individually or in combination, should teach or suggest all of the limitations of the rejected claims. However, as indicated above with respect to the response to the rejection under 35 U.S.C. §102, it was noted that Rivette fails to disclose or show each and every element of the rejected claims. It is respectfully asserted that Coleman fails to cure the deficiency as noted above relative to Rivette. Therefore, without addressing whether or not the combination of Rivette in view of Coleman is proper, it is nonetheless asserted the combination would fail to provide all of the elements of the pending claims. Assignee therefore respectfully requests that the Examiner withdraw his rejection of these claims on this ground.

Failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance of acquiescence of the Examiner's position. It is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Assignee does not agree. Instead, it is believed that the foregoing addresses the issues raised by the Examiner and that the present claims are in condition for allowance.

Conclusion

In light of the foregoing, reconsideration and allowance of the pending claims is hereby earnestly requested. Assignee respectfully submits that pending claims 1-40 are in condition for allowance and a notification of such allowance is respectfully requested. If the Examiner believes that there are remaining informalities that are correctible by an Examiner's amendment, a telephone call to the undersigned at 503-439-6500 is respectfully submitted. Any fees or extensions of time believed to be due in connection with this response are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3130.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, Howard Skaist, at (503) 439-6500 if there remains any issue with allowance.

Respectfully submitted,

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Dated: 4/8/2010

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